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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,079	03/30/2001	Errol C. Heiman	STL9524	6981

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/823,079

Applicant(s)

HEIMAN ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-21,23-31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-21,23-31 and 33-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*Continued Examination*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/11/2006 has been entered.

*Claim Status:*

Claims 18-21, 23-31 and 33-36 are pending; claims 1-17, 22, 32 and 37 have been canceled. Claims 18-21, 23-31 and 33-36 are rejected as detailed below.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 18 recites “an additional power source.” The purpose of the additional power source is unknown and thus the skilled artisan would not know how to make and use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim     rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites “which is capable of supplying an additional voltage level.” The claim limitation is indefinite because it is unclear whether the additional voltage level is actually functioning as a part of the invention. The same rejection applies to the claim limitation “which is capable of supplying a plurality of selectable voltage levels.”

Claim 18 recites “an additional voltage level that is different from the plurality of selectable voltage levels.” The metes and bounds of the claim limitation is difficult to determine because it is unclear exactly what comprises “different from the plurality of selectable voltage levels.”

Claim 18 recites “an additional power source having a second voltage output which is capable of supplying an additional voltage level.” The scope of the invention cannot be determined because it is unclear exactly what comprises “a second voltage output” and exactly what comprises “an additional voltage level.”

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either an asserted utility or a well established utility.

Claim 18 does not possess a real world practical application that has a useful, concrete and tangible result for the reasons given below.

The preamble claims a "power test." It is confusing because it is unclear whether a power source is being tested or whether the performance of an electronic device is being tested.

The electronic device has one and only one nominal voltage and therefore, it is unclear why a plurality of selectable voltage levels are required.

The purpose of introducing disturbances into the constant power supply voltage is not useful because it is a constant power supply voltage.

The purpose of the additional voltage power source is unknown.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-20, 24-30 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 5,970,074 issued to Ehiro (hereafter Ehiro).

Claims 18 and 28:

Ehiro discloses:

a multi-voltage power source having a first voltage output, which is capable of supplying a plurality of selectable voltage level for a constant power supply voltage at a nominal power supply voltage of an electronic device

circuitry configured to introduce controllable disturbances into the constant power supply voltage [Figs 4 and 5, col 7, lines 10-50]

an additional power source having a second voltage output, which is capable of supplying an additional voltage level that is different from the plurality of selectable voltage levels<sup>1</sup>

Claims 19 and 29:

Ehiro discloses wherein the disturbance is a rising pulse having a maximum voltage which is controllable [Fig 5]

Claims 20 and 30:

Ehiro discloses wherein the disturbance is a low-going pulse having a minimum voltage being less than the nominal power supply voltage [Fig 5]

Claims 24 and 34:

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<sup>1</sup> Due to the above multiple rejections of form, this claim limitation is not given patentable weight.

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Ehiro discloses a manually operated user interface used to control the disturbances [col 2, lines 20-25]

Claims 25 and 36:

Ehiro discloses wherein the disturbance is a plurality of pulses and a frequency and a number of pulses in the plurality of pulses are controllable [Fig 5]

Claim 26 and 35:

Ehiro discloses wherein the disturbance is at least one pulse having a duration and a magnitude which are controllable [Fig 5]

Claim 27:

Ehiro discloses wherein the disturbance comprises a voltage sequence applied during powering up of the electronic device [Fig 5]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehiro in view of US Pat No 5,386,183 issued to Cronvich et al (hereafter Cronvich).

Claim 21 and 31:

Ehiro discloses the elements of claims 18/28 as noted above but does not disclose wherein the constant power supply voltage is selected from the group of voltages consisting of +5 VDC and +12 VDC. Cronvich discloses wherein the constant power supply voltage is selected from the group of voltages consisting of +5 VDC and +12 VDC [Fig 3 and col 12, lines 23-26]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ehiro to include wherein the constant power supply voltage is selected from the group of voltages consisting of +5 VDC and +12 VDC as taught by Cronvich for the purpose of providing a power source suitable for many microcomputer and logic circuits [col 12, lines 23-26].

Claims 23 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehiro in view of US Pat No 4,764,652 issued to Lee et al (hereafter Lee).

Claims 23 and 33:

Ehiro discloses the elements of claims 18 and 22/ 28 and 32 as noted above but does not disclose wherein the additional voltage is +24VDC. Lee discloses +24VDC [col 1, lines 55-60]. It would have been obvious to one of ordinary skill in the art at the time the invention was made



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to modify Ehiro to include wherein the additional voltage is +24VDC as taught by Lee for the purpose of including a power supply voltage that is used for telecommunications equipment [col 1, lines 55-60].

### *Response to Arguments*

Applicant's arguments filed 10/4/2006 have been considered but are not persuasive.

Claim 18 is rejected a plurality of times under the first paragraph of 35 USC 112 and under the second paragraph of 35 USC 112.

Furthermore, examiner is unable to provide art rejection of the limitation "an additional power source" because the purpose of the additional power source is unknown.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P LeRoux whose telephone number is (571) 272-4022.

The examiner can normally be reached Monday through Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

11/9/2006

*EP LeRoux*

*Primary Examiner*